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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,723	01/17/2001	Yasuo Koishihara	53466/295	4861

22428 7590 02/28/2007
FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
EWOLDT, GERALD R	
ART UNIT	**PAPER NUMBER**
1644	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/760,723	KOISHIHARA, YASUO	
	Examiner	Art Unit	
	G. R. Ewoldt, Ph.D.	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *13-24* is/are pending in the application.

4a) Of the above claim(s) *14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13 and 15-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed 12/27/06 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's remarks filed 12/27/06 have been entered.

2. Claim 14 stands withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Claims 13 and 15-24 are being acted upon.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 13 and 15-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,298,420 (1994) in view of Goto, T., et al. (1994, IDS) for the reasons of record set forth in the paper mailed 9/22/03.

As set forth previously, The '420 patent teaches a method of inhibiting B lymphocyte activation (by killing the lymphocyte) for the treatment of an autoimmune disease or a B cell cancer comprising administering a monoclonal antibody which binds B cells (see particularly column 1, lines 27-39 and column 6, lines 45-57).

The reference teaching differs from the claimed invention only in that it does not teach the use of the chimeric, humanized monoclonal antibody HM1.24 which binds SEQ ID NO:1.

Goto, T., et al. teaches the use of the chimeric, humanized monoclonal antibody HM1.24, which binds the protein encoded by SEQ ID NO:1, on terminally differentiated B cells for the treatment of multiple myeloma (see particularly page 1922, column 2, paragraph 1 and page 1929, column 1 paragraph 1).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to perform a method of inhibiting B lymphocyte activation (by killing the lymphocyte) for the treatment of an autoimmune disease, comprising administering a monoclonal antibody, as taught by the'343 patent, employing the humanized monoclonal antibody HM1.24 which binds the protein encoded by SEQ ID NO:1, as taught by Goto, T., et al. as the specific monoclonal antibody. One of ordinary skill in the art at the time the invention was made would have been motivated to use the HM1.24 because said antibody was known to selectively bind terminally differentiated B cells, as taught by Goto, T., et al., and would thus, be an obvious choice (as an equivalent of the antibody of the '420 patent) for the elimination of said cells and the treatment of any disease (such as a B cell-mediated autoimmune disease) which said cells mediate. Note that the substitution of equivalents, in this instance different B cell-binding antibodies, is considered to be obvious.

Applicant's arguments, filed 12/27/06, have been fully considered but they are not persuasive. Applicant again reviews the references and argues that Goto et al. does not teach the administering of antibodies to inhibit lymphocyte proliferation and the teachings of the '420 patent do not extend beyond targeting migis epitopes. Applicant further argues that the '420 patent teaches cytotoxic activity as a preferred method of immunosuppression whereas the instant invention does not recite the use of cytotoxic activity.

Regarding the teachings of the individual references, it is the combined teachings, "in view of the knowledge generally available to one of ordinary skill in the art" (MPEP 2143.01) that render the method of the instant claims obvious. Adequate motivation to combine the references is set forth in the rejection. It is further noted that Applicant has not addressed the finding that the invention comprises the substitution of one known equivalent for another. Regarding cytotoxic activity as a method of immunosuppression, said activity is encompassed by the method of the instant claims, whether specifically recited in the claims or not.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 13 and 15-24 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the specification provides insufficient evidence that the antibody employed in the claims could bind T lymphocytes as is required by the claimed method,

As set forth previously, a further review of Goto et al. shows that the reference teaches that the anti-HM1.24 antibody is B cell specific. Table 1 teaches that the antibody does not bind T cells. Thus, the teachings of Goto et al. directly contradict the findings of the instant disclosure. The most scientifically reasonable conclusion would be that the antibody binds some T cells (i.e., the T cells of the specification), but not others (i.e., the T cells of Goto et al.). Clearly then, an unpredictability has been established, at least as the claimed invention encompasses a method that requires the binding of the amino acid sequence of SEQ ID NO:1 and the binding of T cells.

Applicant's arguments, filed 12/27/06 have been fully considered but they are not persuasive. Applicant argues that Goto et al. may not have detected T cells as the T cells of the reference were not concentrated and may have been below the threshold of detection. Further, Applicant argues that HM1.24 does indeed bind T cells and submits Vidal-Laliena et al. in support.

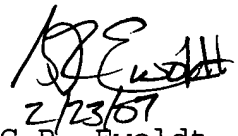
Applicant is advised that enablement must be established at the time of filing or as of an application's priority date. In this instance the date is 2/27/98. While Vidal-Laliena et al. may indeed show that T cells express the HM1.24 antigen, said showing was not until 2005. On the other hand, Goto et al. in 1994 taught that cells bound by HM1.24 were "clearly $CD3^-$", (page 1926, column 2) i.e., they were not T cells. Thus, the method of the instant claims was not enabled for the inhibition of T cell activation in 1998. Regarding the assertion that Goto et al. may not have detected T cells as the T cells of the reference were not concentrated and may have been below the threshold of detection, said assertion comprises only an attorney's argument and is not found persuasive.

7. No claim is allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571)272-0843. The

examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

9. **Please Note**: Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



2/23/07

G.R. Ewoldt, Ph.D.
Primary Examiner
Technology Center 1600